

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102

Claims 1-9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wang et al. (USPN 6,526,155).

The rejections are respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 200 U.S. App. LEXIS 6300, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

The invention of the present application recognizes the that the conventional technique of synthesizing an additional image in a halftone image region (see page 2, line 23 to page 3, line 3 of the present specification) has a problem, and the present invention was perfected with a view to solving this problem. The invention recited in claim 1 of the present application includes discriminating a text area from a received image data and synthesizing an additional image with the text area. On the other hand, the invention recited in claim 7 of the present application includes discriminating a non-text area from a received image data and synthesizing an additional image with an area other than the non-text area.

According to the invention recited in claim 1, even when the additional image is synthesized in the text area, this synthesis will not render the text itself unreadable, but will manifest an effect of enhancing the discernibleness of the additional image and the original image.

In contrast, the apparatus described in Wang et al. is intended to synthesize a visible watermark with an input image. As regards the manner of deciding the position for making this synthesis, the position is decided where the gray-scale range falls in a prescribed range (col. 4, lines 3 - 34). Further, the halftone at this position is altered and a visible watermark is synthesized with the resultant halftone image (col. 4, lines 35 - 50). Wang et al. is nothing other than the conventional technique described in the specification of the present application and, therefore, entails such a problem as described at line 12, page 3 - line 2, page 4 of the specification of the subject patent application. Incidentally, when the position for making the synthesis is decided simply on the basis of the fact that the gray-scale range falls in the prescribed range (threshold), neither the text area nor the non-text area can be discriminated.

Thus, Wang et al. merely describes the conventional technique contemplated in the present application and neither discloses nor suggests the act of discriminating a text area or the act of discriminating a non-text area. Moreover, the act of synthesizing an additional image in the text area or in the area other than the non-text area (claim 7) is neither described nor mentioned anywhere in Wang et al.

The above argued difference(s) between the claimed device vis-à-vis the device of Wang et al. undermine the factual determination that Wang et al. identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that independent claims 1 and 7, as well as dependent claims 2-6, 8 and 9, are not anticipated by Wang et al., for the reasons described above. Consequently,

Applicants respectfully solicit withdrawal of the rejections of claims 1-9 under 35 U.S.C. § 102 as being anticipated by Wang et al., as well as the allowance of claims 1-9.

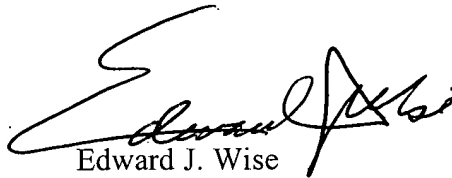
CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Edward J. Wise', is written over a horizontal line.

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